

10/732,843
END-5007USNPRemarks

Status of Claims:

Claims 1-20 are rejected. Claims 16 and 17 are amended. Claims 1-20 remain pending.

The claims were amended in accordance with the amendments above. Applicant notes that claim 16 has been amended merely to correct two minor typographical errors. Claim 17 has been amended to focus the claim on those aspects of the invention that are a commercial priority of the assignee. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

§ 102 Rejections:

Claims 1-3, 7, 9-13, and 17-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Gregoire et al. (U.S. Patent No. 5,944,673). Applicant respectfully traverses these rejections.

Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicant submits that Gregoire et al. fails to anticipate independent claim 1, amended independent claim 16, and amended independent claim 17.

Claim 1 and amended claim 16 each recite a sample tube having an "open distal end." Gregoire et al. fails to teach or suggest a sample tube having an open distal end, particularly in the arrangement required by the claims. The Office cites the "tissue extractor" (65) of Gregoire et al. as the claimed "sample tube," and further states that this tissue extractor has an open distal end. Applicant respectfully submits that this reading of Gregoire et al. is inconsistent with the specification and drawings of Gregoire et al. For instance, at column 7, lines 3-6, Gregoire et al. explicitly states that the distal end of the tissue extractor is "closed," which is directly contrary to the open distal end recited in claim 1 and in amended claim 16. Indeed, the disclosure of Gregoire et al. teaches that the distal end of the tissue extractor of Gregoire et al. is closed with a plate (67). The closed distal end of the tissue extractor in Gregoire et al. is also illustrated in Figs. 2 and 4, where the plate closing the distal end can be easily seen. Accordingly, Applicant respectfully submits that Gregoire et al. fails to anticipate claim 1 and amended claim 16 in accordance with MPEP 2131, and respectfully request that the rejections be withdrawn.

- 5 -

Doc 21920v1

10/732,843
END-5007USNP

Independent claim 16 has also been amended to recite an "open distal end" of a hollow sample tube, and that "the tissue sample is axially received in the hollow sample tube through the open distal end of the hollow sample tube during the act of advancing the hollow sample tube." Accordingly, for at least the same reasons that Gregoire et al. fails to anticipate amended claims 1 and 16, Gregoire et al. fails to anticipate amended claim 17 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

§ 103 Rejections:

Claims 4-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Gregoire et al. in view of Bates et al. (U.S. Patent No. 6,273,861). Claims 8 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Gregoire et al. in view of Burbank et al. (U.S. Patent No. 5,526,822). Claims 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Gregoire et al. in view of Tsonton et al. (U.S. Pub. No. 2004/0077972). Claims 18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Gregoire et al. in view of Chin et al. (U.S. Patent No. 5,195,533). Applicant respectfully traverses these rejections.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each amended independent claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

With respect to independent claims 1 and 16, Applicant notes that each of the claims recites "a sample tube having an open distal end . . . and advancable within the cutter." As

10/732,843
END-5007USNP

discussed above with respect to the §102 rejections of claims 1 and 16, Gregoire et al. fails to teach or suggest such limitations. Applicant further submits that the other cited references, even in combination, fail to make up for this deficiency of Gregoire et al. Accordingly, the combined art of record fails to render independent claim 1 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

Similarly, with respect to amended independent claim 17, Applicant notes that the claim recites an "open distal end" of a hollow sample tube, and that "the tissue sample is axially received in the hollow sample tube through the open distal end of the hollow sample tube during the act of advancing the hollow sample tube." As discussed above with respect to the §102 rejection of claim 17, Gregoire et al. fails to teach or suggest such limitations. Applicant further submits that the other cited references, even in combination, fail to make up for this deficiency of Gregoire et al. Accordingly, the combined art of record fails to render amended independent claim 17 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). Instead of providing the requisite evidence in the prior art suggesting the desirability of the invention claimed herein, the Office instead relies solely on conclusory statements and impermissible hindsight reconstruction. Because the evidence of motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejection be withdrawn.

Beyond the foregoing shortcomings with respect to the rejections of the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that

- 7 -

Doc 21920v1

10/732,843
END-5007USNP

several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

/Andrew B. Ulmer/
Andrew B. Ulmer
Reg. No. 57,003
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(513) 337-3535